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09/802,103

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EXAMINER

KENNEDY, JOSHUA T

ART UNIT

PAPER NUMBER

3679

NOTIFICATION DATE

DELIVERY MODE

01/18/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 09/802,103 | Applicant(s) GUERIT ET AL. | |
| | Examiner JOSHUA T. KENNEDY | Art Unit 3679 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-17, 20, 21, 24 and 32-42 is/are pending in the application.
- 4a) Of the above claim(s) 38-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-17, 20, 21, 24 and 32-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I in the reply filed on 10/3/2002 is acknowledged. The traversal is on the ground(s) that no restriction was made in the examination of a related case and "for uniformity of examination no restriction requirement appears to be justified in the present application" (Page 13). This is not found persuasive because applicant has failed to provide any evidence to support the general allegation of no serious burden. In this regard, it should also be noted that there are no generic claims present and thus it is not clear why these would be no serious burden to have to examine (which includes searching, review of any prior art references, consideration of the claims, and consideration of arguments) claims that are drawn to the other, non-elected, invention. No reasoning has been provided to establish why one would have to conduct a search for an x-ray machine when examining a device for flexibly connecting two rigid members and none is seen to exist.

Further, the examiner has shown the two inventions to be distinct, i.e., by showing that the combination does not require the particulars of the subcombination and by showing the subcombination has separate utility, and applicants have failed to point out any errors in this showing. Further, the examiner has established separate status in the art by showing separate classification. As set forth by MPEP 808.02, this is sufficient to meet the showing of "serious burden". It should further be noted that a serious burden would be imposed on the examiner as a result of the different

Art Unit: 3679

subclasses that would have to be searched and different search queries that would have to be employed to search the process.

The requirement is still deemed proper and is therefore made FINAL.

Claims 38-42 have been withdrawn.

Claims 2-17, 20, 21, 24 and 32-37 have been examined.

Claims 1, 18, 19, 22, 23 and 25-31 have been cancelled.

Claim Objections

Claim 35 is objected to because of the following informalities: Claim 35 is a duplicate of Claim 24. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-17, 20, 21, 24 and 32-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear whether the claims are drawn to the combination or subcombination. In particular, the preamble of each of the claims imply the subcombination of the device for the expressed intended use of "for joining at least two structural units" the two units having a means for connecting extending there between, the body of the claims then positively include the means for

connecting and the two units (and the covers thereof). For this Office action only, it will be considered that these claims are drawn to the subcombination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4, 20, 24, 32, 33 and 35-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmidt (US Patent 561,441).

As to Claim 32, as best understood Schmidt discloses a device capable of joining at least two structural units, the units having relative rotational and translational mobility with each respect to each other and means for connecting extending between the two units, each unit having respective cover, comprising:

each unit cover having an aperture with margins or edges (Fig 1);

an intermediate cover (A) disposed between the respective covers of the two units (Figs 1-2);

the intermediate cover having two ends, each end having a respective aperture with a margin or edge (Fig 1);

each of the intermediate cover margins or edges being joined to a respective margin or edge of the unit covers (Fig 1);

the unit covers apertures and the intermediate cover apertures being of complimentary profile (Fig 1);

the intermediate cover being a flexible hollow element (Fig 1) capable of surrounding or enclosing a means for connecting and shaped to follow a relative mobility of the two units without forming creases in the element (Fig 1).

As to Claim 4, as best understood Schmidt discloses a device according to claim 32, wherein the intermediate cover element is in a sheath form (Fig 1).

As to Claim 20, as best understood Schmidt discloses a device according to claim 32, wherein the ends of the intermediate cover are cemented at margins of the apertures of the unit covers (Page 1, lines 83-84; Examiner notes the broad definition of cement as "something that serves to bind or unite" (Webster's New World Dictionary, College Edition, ©1968 The World Publishing Co.). In this case, Examiner considers the water tight seal as something that serves to 'unite' the intermediate cover to the pipe members).

As to Claims 24 and 35, as best understood Schmidt discloses a device according to claim 32, wherein the means for connecting comprises mechanical or electrical or fluid connections between the structural units (Fig 1).

Art Unit: 3679

As to Claim 33, as best understood Schmidt discloses a device according to claim 32 wherein one of the structural unit covers is fixed and the other structural unit cover is relative mobile with respect to the fixed structural unit cover (Fig 1).

As to Claim 36, as best understood Schmidt discloses a device according to claim 33 wherein the means for connecting comprises mechanical or electrical or fluid connections between the structural units (Fig 1).

As to Claim 37, as best understood Schmidt discloses a device according to claim 33 wherein one of the structural unit covers is fixed and the other structural unit cover is relative mobile with respect to the fixed structural unit cover (Fig 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 5-17, 21 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt.

As to Claim 2, as best understood Schmidt discloses a device according to claim 32, wherein the unit covers structural features are arranged at an angle to one another, and

at least one of two ends of the element is joined to the corresponding structural features in at least two contiguous sides of the structural feature (Figs 1-2).

However, Schmidt does not disclose the unit covers being generally parallelepipedal in shape. Schmidt does not disclose any structural or functional significance as to the shape of the unit covers. A change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Accordingly it would have been obvious to one of ordinary skill in the art to modify the assembly of Schmidt to have the unit covers being are generally parallelepipedal in shape as the reference does not disclose any structural or functional significance as to the shape of the unit covers as this is merely a change in shape producing expected and predictable results.

As to Claim 3, as best understood Schmidt discloses a device according to claim 2, wherein the angle is approximately a right angle (Fig 1).

As to Claim 5, as best understood Schmidt discloses a device according to claim 2, wherein the intermediate cover element is in a sheath form (Fig 1).

As to Claims 6-13, as best understood Schmidt discloses a device significantly as claimed, but does not disclose wherein the intermediate cover element is made of silicone of about 40 to 60 Shore hardness, specifically about 50 Shore hardness. Although Schmidt discloses that the cover "is preferably made of soft rubber, but may be made of any other soft material capable of the same use" (Page 1, lines 34-36),

Art Unit: 3679

Schmidt does not disclose any structural or functional significance as to the specific material of the intermediate cover. The selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Accordingly it would have been obvious to one of ordinary skill in the art to modify the assembly of Schmidt to have the intermediate cover element is made of silicone of about 40 to 60 Shore hardness, specifically about 50 Shore hardness as the reference does not disclose any structural or functional significance as to the specific material of the intermediate cover as this is merely a change in shape producing expected and predictable results.

As to Claims 14-17, as best understood Schmidt discloses a device significantly as claimed, but does not disclose wherein the intermediate cover element has a thickness of between about 2 and 5 mm. However, although silent on the dimension, Schmidt does not disclose any structural or functional significance as to the thickness of the intermediate cover, but the intermediate cover inherently has a thickness relative to the size of the assembly. A change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955). Through routine experimentation and optimization, it would have been obvious to one of ordinary skill in the art to modify the assembly of Schmidt to have said intermediate cover element having a thickness of between about 2 and 5 mm as the reference does not disclose any structural or functional significance as to the thickness

Art Unit: 3679

of the intermediate cover as this is merely a change in size producing expected and predictable results.

As to Claim 21, as best understood Schmidt discloses a device according to claim 2, wherein the ends of the intermediate cover are cemented at margins of the apertures of the unit covers (Page 1, lines 83-84; Examiner notes the broad definition of cement as "something that serves to bind or unite" (Webster's New World Dictionary, College Edition, ©1968 The World Publishing Co.). In this case, Examiner considers the water tight seal as something that serves to 'unite' the intermediate cover to the pipe members).

As to Claim 34, as best understood Schmidt discloses a device capable of joining at least two structural units, the units having relative rotational and translational mobility with each respect to each other and being at substantially a right angle to each other and means for connecting extending between the two units, each unit having respective cover, comprising:

- each unit cover having an aperture with margins or edges (Fig 1);

- an intermediate cover (A) disposed between the respective covers of the two units;

- the intermediate cover having two ends, each end having a respective aperture with a margin or edge (Fig 1);

each of the intermediate cover margins or edges being fixedly joined to a respective margin or edge of the unit covers (Fig 1) and

the intermediate cover being a flexible hollow element in a sheath form surrounding or enclosing the means for connecting and shaped to follow the relative mobility of the two units without forming creases in the element (Fig 1).

However, Schmidt does not disclose the unit covers apertures and the intermediate cover apertures being of a complimentary generally parallelepipedal profile or the intermediate cover being formed of a silicone having a Shore hardness of about 40 to 60 and a thickness of about between 2 and 5 mm.

Schmidt does not disclose any structural or functional significance as to the shape of the unit covers. A change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Accordingly it would have been obvious to one of ordinary skill in the art to modify the assembly of Schmidt to have the unit covers being are generally parallelepipedal in shape as the reference does not disclose any structural or functional significance as to the shape of the unit covers as this is merely a change in shape producing expected and predictable results.

Although Schmidt discloses that the cover "is preferably made of soft rubber, but may be made of any other soft material capable of the same use" (Page 1, lines 34-36), Schmidt does not disclose any structural or functional significance as to the specific material of the intermediate cover. The selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re

Art Unit: 3679

Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Accordingly it would have been obvious to one of ordinary skill in the art to modify the assembly of Schmidt to have the intermediate cover element is made of silicone of about 40 to 60 Shore hardness, specifically about 50 Shore hardness as the reference does not disclose any structural or functional significance as to the specific material of the intermediate cover as this is merely a change in shape producing expected and predictable results.

Although silent on the dimension, Schmidt does not disclose any structural or functional significance as to the thickness of the intermediate cover, but the intermediate cover inherently has a thickness relative to the size of the assembly. A change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955). Through routine experimentation and optimization, it would have been obvious to one of ordinary skill in the art to modify the assembly of Schmidt to have said intermediate cover element having a thickness of between about 2 and 5 mm as the reference does not disclose any structural or functional significance as to the thickness of the intermediate cover as this is merely a change in size producing expected and predictable results.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

Art Unit: 3679

obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 32 and 34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,550,964. Although the conflicting claims are not identical, they are not patentably distinct from each other because both recite devices for joining at least two structural features having a relative mobility, the device covering connecting means and the features having

respective apertures comprising a flexible hollow element that is shaped so as to cover the means for connecting with end which are joined to the apertures of the covers.

Response to Arguments

Applicant's arguments with respect to claims 2-17, 20, 21, 24 and 32-37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patents 5069643, 5189686, 5685328, 5883938, 6303870 and 6397882 have all been cited to show similar covers.

Applicant's amendment, specifically the addition of the limitation of the intermediate covers are shaped to follow the relative mobility of the two units without forming creases in the element (Claims 32, Lines 13-15 and Claim 34, lines 13-15) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3679

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA T. KENNEDY whose telephone number is (571)272-8297. The examiner can normally be reached on M-F: 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joshua T. Kennedy/
Primary Examiner, Art Unit 3679
1/12/2010